



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,242	05/15/2001	Ryohei Sato	14632	8991

23389 7590 10/06/2005

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT PAPER NUMBER

2686

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,242

Applicant(s)

Sato

Examiner

Rafael Perez-Gutierrez

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2686

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on May 25, 2005. **Claims 10-20** are still pending in the present application. **This Action is made FINAL.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. **Claims 10-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokoro (U.S. Pat. No. 6,349,324) in view of Tsai (U.S. Pat. No. 6,757,301).

Regarding **claim 10**, Tokoro discloses a cellular telephone apparatus which has a cellular telephone set capable of originating a plurality of calls to a base station (*col. 4, lines 48-50; Fig.*

Art Unit: 2686

1) and communicating with an accessory through sub-communication means (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and said accessory capable of communicating with said cellular telephone set through said sub-communication means (*Fig. 3, items 37, 39-40, 202, and 205*), and can execute a communication function other than a voice communication function by said cellular telephone set through said sub-communication means (Generating an infrared request signal for television-telephone connection; *col. 8, lines 49-62*), said cellular telephone set comprising: cellular telephone transceiver means for originating a plurality of calls to a base station (*Fig. 2, radio communication unit, items 22, and 23*); sub-communication means for performing communication with said accessory by means of a call through a channel (*Fig. 3, items 37, 39 and 40*); control means for causing said cellular telephone transceiver means to start originating a call other than a call used by the cellular telephone set to perform sub-communication with the accessory for voice communication with a remote cellular telephone set (Turning off the television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*), and said accessory comprises: sub-communication means for performing communication with said cellular telephone set (*Fig. 3, items 37, 39-40, 202, and 205*); expression means for expressing a content transferred by said sub-communication means (*Figs. 1 and 4, items 205 and 305*). Tokoro fails to specifically disclose both cellular telephone apparatus and accessory comprising channel monitoring means for monitoring channel quality of said sub-communications means and control means for when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level notifying said

Art Unit: 2686

cellular telephone set of the corresponding information and causing said cellular apparatus to start originating a call. Tokoro however does suggest the aforesaid limitation such as one user using a portable-telephone device moving from one place to another wherein degradation or deterioration of a channel or a communication path such as infrared communications can occur as a result of the user moving away from an accessory or terminal adapter, thus utilization or employment of an expression or image display means is unnecessary at that particular instance.

Furthermore in the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the quality of a communication means for switching between appropriate communication modes as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Regarding **claims 11 and 12**, and as applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. In addition Tokoro discloses wherein said accessory comprises a

Art Unit: 2686

videophone unit and a musical unit (A television unit for generating video ad audio signals; *col. 7, lines 4-20; Fig. 1, item 205*).

Regarding **claims 13-15**, and as each applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. In addition Tokoro discloses wherein said sub-communication means is infrared communication (*Fig. 1, infrared ray*).

4. **Claims 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokoro (U.S. Pat. No. 6,349,324) in view of Tsai (U.S. Pat. No. 6,757,301), further in view of Tryding (U.S. Pat. No. 5,880,732).

Regarding **claims 16-18**, and as each applied to claim 10, Tokoro in view of Tsai disclose the aforementioned apparatus. Tokoro in view of Tsai fail to clearly specify wherein said sub-communication is a radio communication.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro in view of Tsai communication system for switching communication modes to include a direct radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Regarding **claim 19**, Tokoro discloses a method for a cellular telephone apparatus including a cellular telephone set capable of originating a call in addition to a call for voice

Art Unit: 2686

communication (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and an accessory capable of communicating with the cellular telephone set through a call by using a channel for sub-communication (*Fig. 3, items 37, 39-40, 202, and 205*), when the cellular telephone set can perform voice communication with a remote cellular telephone set (*col. 4, lines 48-50; Fig. 1*), the cellular telephone set is allowed to perform voice communication with the remote cellular telephone set by originating a call other than a call used by the cellular telephone set to perform said sub-communication with the accessory (Turning off the television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*). Tokoro fails to specifically disclose wherein the channel is a radio channel and the channel quality of a channel for the sub-communication deteriorating to not more than a predetermined level. Tokoro however does suggest the deterioration of the channel to not more than a predetermined level such as one user using a portable-telephone device moving from one place to another wherein degradation or deterioration (a predetermined level relative for determining deterioration) of a channel or a communication path such as infrared communications can occur as a result of the user moving away from an accessory or terminal adapter, thus utilization or employment of an expression or image display means is unnecessary at that particular instance.

In the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for

Art Unit: 2686

example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the quality of a communication means for switching between appropriate communication modes as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Tokoro in view of Tsai fail to clearly specify wherein the channel for sub-communication is a radio channel.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro in view of Tsai communication system for switching communication modes to include a direct radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Regarding **claim 20**, Tokoro discloses A communication method of communicating between cellular telephone apparatuses with each other, each of said apparatuses including a cellular telephone set capable of originating a call in addition to a call for normal voice communication (*col. 4, lines 56-58; Fig. 1, items 22 and 23*), and an accessory capable of

Art Unit: 2686

communicating with the cellular telephone set by making use channel for sub-communication through a call (*Fig. 3, items 37, 39-40, 202, and 205*), comprising the steps of: inputting a telephone number of a remote cellular telephone apparatus by operating a ten-key mounted in an originating cellular telephone apparatus so as to start the sub-communication (*col. 5, lines 36-42; Fig. 2, items 16 and 16A*); transmitting corresponding information through infrared light from the accessory to a cellular telephone set mounted in said originating cellular phone apparatus so as to originate a call (*col. 5, lines 56-63; col. 8, lines 48-53; Fig. 2, item 16A*); starting communication from the cellular telephone set mounted in said originating cellular telephone apparatus to the remote cellular telephone apparatus through base stations (*col. 7, line 63 thru col. 8, line 7; Fig. 1, items 201, 301, 231-1, and 231-2*) and activating display units to transmit and receive a sensed image signal and the like and display a corresponding images so as to perform videophone communication (*col. 12, line 8 thru col. 13, line 7*); checking whether communication using a voice call can be performed between cellular telephone sets respectively mounted in said cellular telephone apparatuses (The portable telephone outputting an electric wave conveying a calling signal to the closest base station, then an electric wave conveying the call signal is transmitted by the base station to another portable telephone for voice communications; *col. 7, line 63 thru col. 8, line 47*); originating a call, other than a call for the sub-communication, from the cellular telephone set mounted in the originating cellular telephone apparatus to the cellular telephone set mounted in the remote cellular telephone apparatus (*col. 7, line 63 thru col. 8, line 47*); starting voice communication when the voice call is originated (*col. 7, line 63 thru col. 8, line 47*); and terminating the sub-communication (Turning off the

Art Unit: 2686

television-telephone button when moving from one room to another to temporarily suspend the television conversation, continuing a telephone conversation based on audio signals; *col. 14, lines 30-51*). Tokoro fails to specifically disclose monitoring a channel quality of the sub-communication whether the channel quality has deteriorated to a predetermined level or less.

In the same field of endeavor Tsai discloses a method for switching operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode, for example if the frames counter exceeds a preset frames counter threshold, the method switches the device from a data transfer mode to a voice mode (*col. 2, lines 54-58; col. 5, lines 10-39*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Tokoro communication system switching between a telephone conversation based only audio signals and telephone television conversation to monitor the quality of a communication means as taught by Tsai for the purpose of operating in an suitable operating mode according to the characteristics of a connection.

Tokoro in view of Tsai fail to clearly specify wherein the channel for sub-communication is a radio channel.

In the same field of endeavor, Tryding disclose a mobile telephone communicating with a display monitor through communication link, wherein RF communications means are employed for generating said communication link (*col. 2, lines 52-61*).

Therefore it would have been obvious to one with ordinary skill in the art, to have Tokoro

Art Unit: 2686

in view of Tsai communication system for switching communication modes to include a direct radio channel between to devices as taught by Tryding for the purpose of enabling communication in a relative large enclosed space environment (i.e., auditorium).

Response to Arguments

5. Applicant's arguments with respect to **claims 10-20** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this

Art Unit: 2686

final action.

7. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 2686

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.



Rafael Perez-Gutierrez

R.P.G./rpg

RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER

October 3, 2005